

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MEREL EPSTEIN

Appeal No. 2002-1030
Application No. 09/603,222

ORDER REMANDING TO EXAMINER

On December 19, 2001, appellant submitted a Reply Brief (Paper No. 15) which appeared to include the submission of an amendment on page 1. 37 CFR § 1.121 (2001) states:

§ 1.121 Manner of making amendments in applications

(a) Amendments in applications, other than reissue applications. Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with

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§ 1.52, directing that specified amendments be made.

The Manual of Patent Examining Procedure (MPEP) § 1208.03 (Eighth Edition, August 2001) states:

Amendments, affidavits, and/or other evidence must be submitted in papers separate from the reply brief, [emphasis added] and the entry of such papers is subject to the provisions of 37 CFR 1.116 and 37 CFR 1.195. A paper that contains an amendment (or evidence) is not a reply brief within the meaning of 37 CFR 1.193(b). Such a paper will not be entitled to entry simply because it is characterized as a reply brief.

There is no indication in the record that the Reply Brief filed December 19, 2001 (Paper No. 15) was considered. The communication that was mailed on February 26, 2002 (Paper No. 16) "in response to appellant's communication filed December 19, 2001 (paper #15)" makes reference only to appellant's Supplemental Brief received October 19, 2001 (Paper No. 13½), the Examiner's Answer (Paper No. 14), and appellant's original Brief (Paper No. 13). 37 CFR § 1.193(b)(1)(2001) states:

(b)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of such examiner's answer. . . . The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief.

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Finally, the Final Rejection mailed May 11, 2001 (Paper No. 8) indicates that claims 1, 7 and 8 are rejected under 35 U.S.C. § 112, second paragraph, and under 35 U.S.C. § 103(a) as being unpatentable over Kantro in view of Cherniak alone, or further in view of Shaw, Smith and Marc. Appellant reiterates this § 112 ground of rejection on pages 3-6 of the Appeal Brief filed October 19, 2001 (Paper No. 13½). In his Answer, however, the examiner only discusses the § 103 rejection. Clarification regarding the status of claims 1, 7 and 8 under 35 U.S.C. § 112, second paragraph, is requested.

Accordingly, it is

ORDERED that the application is remanded to the
Examiner:

1. to inform appellant to submit the amendment included in the Reply Brief filed December 19, 2001 (Paper No. 15) in proper format and on a separate paper (If the amendment is entered, appellant will need to submit a new Appendix to the Appeal Brief filed October 19, 2001 (Paper No. 13½) or the Examiner will need to issue a supplemental Examiner's Answer which contains a correct copy of the claim.);

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2. for consideration and proper response to the Reply Brief filed December 19, 2001 (Paper No. 15);

3. for clarification regarding the § 112, second paragraph, rejection of claims 1, 7 and 8; and

4. for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

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A handwritten signature in black ink, appearing to read 'Dale Shaw', is written over a horizontal line.

DALE SHAW
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DS:psb

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